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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,261	10/15/2001	David Y. Zhang	251305.0028 SBP/MCD	4119
<div>7590 08/29/2007 Steven B. Pokotilow, Esq. Stroock & Stroock & Lavan LLP 180 Maiden Lane New York, NY 10038</div>			<div>EXAMINER LU, FRANK WEI MIN</div>	
			<div>ART UNIT 1634</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 08/29/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/978,261	Applicant(s) ZHANG, DAVID Y.	
	Examiner Frank W. Lu	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 40-44.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal; but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 7/27/2007
13. ☐ Other: _____.

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on August 11, 2007 have been fully considered and have been entered.

Response to Arguments

I. In page 4, second paragraph of applicant's remarks, applicant argues that the amendments on claim 42 have overcome the rejection under 35 USC 112, second paragraph.

This argument has been fully considered. However, claim 42 is unclear in view of steps (a) and (d) because a signal cannot be generated by separating the signal generating moiety and the quenching, masking or inhibitory moiety when the signal generating moiety is an enzyme or enzyme substrate.

II. In page 5, second paragraph bridging to page 6, first paragraph of applicant's remarks, applicant argues that "[A]s stated *supra*, Applicants' Petition was granted and the subject application now claims priority to Zhang and thus Zhang is not be available as a 35 U.S.C. §103(a) reference. Applicants respectfully submit that neither Wang nor Harris alone or in combination render claims 40-42 obvious. Applicants also respectfully submit that neither Wang, nor Harris, nor Heller alone or in combination render claim 43 obvious. Applicants also respectfully submit that neither Wang, nor Harris, nor Heller, nor Segev alone or in combination render claim 44 obvious".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejections. Although applicant claims priority for PCT/US95/07671 (WO 95/35390) and Zhang *et al.*, (US Patent No. 5,942,391), since the examiner cannot find the

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support in these references for amplifying a circular probe using a pair of primers comprising a first primer and a second primer wherein the first primer comprises a first sequence that is complementary to the circular probe, a second sequence that is complementary to the second primer of the pair, and a signal generating moiety, and the second primer of the pair comprises a sequence that is complementary to the first primer and a moiety capable of quenching, masking or inhibiting the activity of the signal generating moiety when located adjacent to, or in close proximity to the signal generating moiety, the priority date of this instant application is considered as a date after the filing date of Zhang *et al.*. Furthermore, applicant does not indicate which part of PCT/US95/07671 (WO 95/35390) and Zhang *et al.*, (US Patent No. 5,942,391) supports claim 42. Therefore, Zhang is available as a 35 U.S.C. §103(a) reference and the rejections under 35 U.S. C 103 are proper.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

August 23, 2007

A handwritten signature in black ink, appearing to read 'Frank Lu', is written above the typed name.

FRANK LU
PRIMARY EXAMINER